

REMARKS

The applicant requests that the double patenting rejections be held in abeyance until the claims are otherwise held allowable.

All of the independent claims now state that the electrically conductive surface has at least a portion recessed in or projecting from the flat, non-conductive surface. Claims 20 and 21 previously recited this subject matter, and the Examiner relied on disclosure in Irion (U.S. Pat. No. 6,251,108) in rejecting claims 20 and 21 as obvious over Lennox (U.S. Pat. No. 5,919,191) in view of Irion, stating:

Regarding claims 20 and 21, Irion discloses that it is well-known in the art to make an electrically conductive surface either flush with or project from a surface (col. 1, ln. 8-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the electrically conductive surface of Lennox either flush with or project from a non-conductive surface in view of the teaching of Irion since these constructions are well-known in the art, and it would have required only routine skill in the art. In addition, applicant has not disclosed any criticality or unexpected result associated with these limitations.

While Irion discusses electrodes having projections or recesses in the background, Irion teaches away from the use of such electrodes:

The invention is therefore based on the problem of providing an electrode for HF surgery, and particularly for vaporizing tissue, which comprises an electrode body rolling over the tissue and suitable to achieve a certain distribution of current density without occurrence of the disadvantages linked up with the use of projections or recesses, respectively. (Irion, col. 1, lines 35-41).

Irion describes filling recesses between electrically conductive projections with an electrically insulating material to form a smooth surface. (Irion, col. 3, lines 33-50).

Therefore, one of ordinary skill in the art, presented with Irion, which teaches away from the use of electrodes having projections or recesses, would not modify the electrode of Lennox to include such projections or recesses. The Examiner is impermissibly picking and choosing from Irion relying on hindsight rather than considering the entire disclosure of Irion.

The Examiner has also relied upon Rosar, Grossi, and Nardella in rejecting certain claims. These references do not overcome the deficiencies in the references discussed above.

Therefore, the applicant submits that the claims are in condition for allowance.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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